AF 1617

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: John J. Murphy *et al.*	Confirmation No. 3501
Application No.: 09/628,803	Group Art Unit: 1617
Filed: July 28, 2000	Examiner: Hui, San Ming R.
For: METHODS AND COMPOSITIONS FOR ALLEVIATING STUTTERING	Attorney Docket No. 215128.03302

APPEAL BRIEF UNDER 37 C.F.R §1.191

BOX Appeal Brief
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Appeal Brief is responsive to the Final Rejection dated April 23, 2003, and a Notice of Appeal filed October 22, 2003.

(1) Real Party in Interest

Indevus Pharmaceuticals, Inc., a Delaware corporation, having its principal office at 99 Hayden Avenue, Suite 200, Lexington, Massachusetts, 02421; by virtue of Assignment from Warner Lambert Company LLC (executed February 9, 2004, submitted for recordation at the USPTO May 7, 2004.)

(2) Related Appeals and Interferences

None.

(3) Status of Claims

Original Claims 1 – 33 are cancelled. Claim 35 is being cancelled by Amendment filed herewith. Claim 34 is active.

(4) Status of Amendments

All pending claims were cancelled by the Amendment filed May 17, 2002, which added claims 34 and 35. Claim 35 was cancelled by Amendment filed herewith. Claim 35 is the sole claim on Appeal.

(5) Summary of the Invention

A method of alleviating stuttering in a subject in need thereof [page 2, line 1], the method comprising administering a therapeutically effective dose of pagoclone or a pharmaceutically acceptable salt thereof [Example 6.1, page 20, line 25 – page 21, line 9].

(6) Issues

Whether Claim 34 would have been obvious under 35 U.S.C. §103(a) over Doble et al. in view of Novo Nordisk and Sandyk.

(7) Grouping of Claims

Claim 34 is the sole claim on Appeal.

(8) Argument

The invention is directed solely to the treatment of stuttering using pagoclone.

Claims 34 stands rejected under 35 U.S.C. §103(a) over Doble et al. in view of Novo Nordisk and Sandyk.

Doble et al. teaches that pagoclone is a partial agonist of $GABA_A$ receptor. The Examiner concedes that the reference does not teach administration of pagoclone for treating stuttering. The

obviousness rejection relies on Novo Nordisk, for teaching that stuttering is a disorder which is (somehow) "related to GABA uptake activity (See abstract)" [Office Action page 2, lines 3 – 4 from bottom], and Sandyk, which teaches that changes in the synthesis and release of GABA itself can improve dysarthria stuttering. The supporting references do not suggest using pagoclone to treat stuttering or provide any motivation to focus on this particular "partial agonist of $GABA_A$ receptor."

This is an 'obvious-to-try" rejection in which the examiner has not shown there would have been a reasonable expectation of success. Therefore, it does not meet the test of obviousness under 35 U.S.C. 103(a). *In re Vaeck* 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The application contains an account of the clinical study that lead to the discovery of pagoclone's effectiveness for treating stuttering. Example 6.1, starting on page 20, is not a prophetic example (although Examples 6.2 and 6.3 are prophetic). The study was a double blind placebo-controlled clinical trial on the safety and efficacy of pagoclone for the treatment of Panic Disorder, a form of anxiety disorder. It was conducted under Dr. Murphy's (an inventor) direct supervision and control.

The twenty-six-year old female patient described in Example 6.1 just happened to have a severe stuttering problem. She experienced a significant reduction in stuttering during the trial, while taking 0.60 mg pagoclone/day, which information was concealed from her until the end of the trial. Both she and the treating clinician noticed this reduction in stuttering and first documented it during week two of the trial.

Upon further investigation Dr. Murphy learned that this patient had previously taken other anti-anxiety medications for her psychiatric condition but had never experienced this sort of effect on her stuttering before. Shortly after the trial concluded, her stuttering problem returned to its pre-drug levels of severity.

At that time (and even today) there were no FDA-approved drugs for the treatment of stuttering. This result was unexpected, and could not have been predicted with a reasonable chance of success, from the general teachings about the role of GABA and stuttering disclosed in Doble, as modified by Novo Nordisk and/or Sandyk. Accordingly, the present invention would not have been obvious within the meaning of 35 USC 103(a).

(9) Conclusion

The examiner has not made out a *prima facie* case of obviousness.

Respectfully submitted,

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Date: **May 24, 2004**

(10) Appendix

34. A method of alleviating stuttering in a subject in need thereof, the method comprising administering a therapeutically effective dose of pagoclone or a pharmaceutically acceptable salt thereof.

35. (Cancelled by amendment submitted herewith)